

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include a change to Fig. 1D (adding element #211). Renumbering of previous Figures 5J, 5K, 5L, 5M, 5N, 5O, 5P, 5Q, 5R, 5S, 5T, 5U, 5V, and 5W as 5I, 5J, 5K, 5L, 5M, 5N, 5O, 5P, 5Q, 5R, 5S, 5T, 5U, and 5V respectively in view of the mis-numbering of Figure 5I. And, the addition of new Fig. 5W.

These sheets, which include Figs. 1D-1E, 5H, 5I, 5J, 5K, 5L, 5M, 5N, 5O, 5P, 5Q, 5R, 5S, 5T, 5U, 5V, and 5W replace the original sheets containing Figs. 1D-1E, 5H, 5J, 5K, 5L, 5M, 5N, 5O, 5P, 5Q, 5R, 5S, 5T, 5U, 5V, and 5W.

Attachment: 6 Replacement Sheets
6 Annotated Sheets

REMARKS

Claims 12-35 are pending in the present application. Applicant believes that no new matter is added by way of this Response.

Concerning the drawings

Applicant submits amended drawings based on previous discussions with the Examiner and requests entry of the attached replacement drawings.

The Office Action indicated that the previous amendments to the drawings were not entered. Applicant is resubmitting the drawing amendments.

The attached sheets of drawings includes a change to Fig. 1D (adding element #211 representing imaging as disclosed in paragraphs [0016], [0040], and [0061]). The attached sheets also include the addition of Fig. 5W showing a plug 573 as disclosed in paragraph [00117].

The attached sheets also include a correction in view of the original mis-numbering of figures, which omitted Fig. 5I. Accordingly, originally numbered figures 5J, 5K, 5L, 5M, 5N, 5O, 5P, 5Q, 5R, 5S, 5T, 5U, 5V, and 5W are renumbered as 5I, 5J, 5K, 5L, 5M, 5N, 5O, 5P, 5Q, 5R, 5S, 5T, 5U, and 5V respectively.

Applicant notes that the specification was previously amended to reflect the above changes and the previous Office Action gave no indication that the previous amendment to the specification was not entered. Accordingly, applicant believes that they have satisfied the objection to the drawings.

Objection to the Specification

The Office Action objected to the specification. By way of the above amendment, applicant correct a typographical error made in the last response. Accordingly, paragraph [0049] now includes a brief description for Figures 5A-5W.

Objection to the Drawings

The previous Office Action objected to the drawings stating that the solid plug, the imaging methods selected from radiography, computer tomography, ultrasound, Doppler, MRI, PET and acoustic imaging, the one way valve, and the self cleaning mechanism must be shown in the drawings or the feature cancelled from the claims.

Applicant amended the drawings to show imaging as recited in the claim. Applicant added Fig. 5W to show the solid plug.

Applicant believes the objection to the drawings based on the one way valve, and the self cleaning mechanism are incorrect.

Applicant notes that the one-way valve is found in Fig. 5U. The text accompanying Fig. 5U (paragraph [00129]) clearly discloses “a variation of the device having a one-way valve 570.”

Applicant also notes that the self cleaning mechanism is shown in Fig. 5J. The text accompanying Fig. 5J (paragraph [00122]) clearly discloses that “in this example, the self cleaning mechanism is a floating ball bearing 532.”

In view of the above, the labeling of two figures as Fig. 5T is now corrected.

35 USC §112 – Claims 22, 24-27, and 29-33

The Office Action rejected claims 22, 24-27, and 29-33 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant disagrees.

The Office Action indicates that claims 22, 24-27, and 29-33 fail to further limit the claims from which they depend, as they merely recite particular structures that do not manipulatively affect the method, and therefore the further limitation is unclear.

Again, applicant disagrees with this rejection. First, the methods in each claim are further limited by the specific element recited in the dependent claim. For example, claim 21 recites providing a medication to the lung where the medication inhibits the healing process of the lung. Claim 22 further limits this method by requiring that the medication is a steroid – a clear limitation from claim 21. In essences, claim 22 recites providing a steroid to the lung where the steroid inhibits the healing process of the lung. This manipulatively affects the method. Claims 24-27 each recite additional elements that further limit the methods from

which they depend. Claims 29-33 recite methods of using conduits of different configurations. Based on this alone, applicant requests withdrawal of this rejection.

Applicant repeats their request that Office Action provides some statutory or legal basis for the standard being set forth in this rejection.

In fact, applicant notes that §2172 of the MPEP clearly states guidelines for rejections under §112 second paragraph (Subject Matter which Applicants Regard as Their Invention): “A rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention.” §2172 of the MPEP citing In re Moore, 439 F.2d 1232, 169 USPO 236 (CCPA 1971)

Clearly the Office Action fails to follow established law as well as the guidelines provided by the Patent Office. Applicant shall address these deficiencies under the appeals process.

The following is a list of partial examples in support of the claim to contradict the Office Action’s rejection:

For claim 22, see paragraph [0030] “The inventive act further includes the act of delivering medications such as steroids.”

For claims 24-26, see paragraph [00117] “The conduit may also be any device capable of maintaining a patent opening, e.g., a plug, that is temporarily used as a conduit and then removed after the channel has healed in an open position. In another variation the plug may be a solid plug without an opening that is either bio-absorbable or removable.”

For claim 27, see paragraphs [00141]-[00143].

For claims 29-33, see figures 5B, 5C, 5D, 5E, 5J (as amended), and 5U (as amended) as well as the text accompanying these figures.

Double Patenting Rejections over US Patent No. 6,692,494

The Office Action rejected claims 12-34 under judicial double patenting over claims 1-74 of US Patent No. 6,692,494. Applicant disagrees.

The Office Action merely states that it is notorious in the art to provide a stent in a surgically created channel in order to prevent reclosure. However, the Office Action fails to address that the claim requires “subsequently removing the conduit after the channel has healed in an open position.”

Regardless, in view of the fact that the ‘494 is in the chain of prior applications applicant shall submit a proper terminal disclaimer on the indication that the claims will be otherwise allowable.

Double Patenting Rejections over US Patent Application No. 10/978,905

The Office Action rejected claims 12-35 under judicial double patenting over claims 1-21 of copending US Patent Application No. 10/978,905. Applicant disagrees.

Regardless of the patentable distinction between the subject application and the copending patent, applicant notes that the MPEP clearly states that “[i]f a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.”

The subject application is filed earlier than the co-pending application in this rejection. Accordingly, applicant submits that upon appeal of the 35 USC §112 first paragraph rejection, this non-statutory obviousness-type double patenting rejection shall be the only rejection remaining and should be withdrawn.

Double Patenting Rejections over US Patent Application No. 10/966,644

The Office Action rejected claims 12-35 under judicial double patenting over claims 1-70 and 180-186 of copending US Patent Application No. 10/966,644. Applicant disagrees.

Regardless of the patentable distinction between the subject application and the copending patent, applicant notes that the MPEP clearly states that “[i]f a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.”

The subject application is filed earlier than the co-pending application in this rejection. Accordingly, applicant submits that upon appeal of the 35 USC §112 first paragraph rejection, this non-statutory obviousness-type double patenting rejection shall be the only rejection remaining and should be withdrawn.

Double Patenting Rejections over US Patent Application No. 10/862,933

The Office Action rejected claims 12-35 under judicial double patenting over claims 1-10 of copending US Patent Application No. 10/862,933. Applicant disagrees.

Regardless of the patentable distinction between the subject application and the copending patent, applicant notes that the MPEP clearly states that “[i]f a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.”

The subject application is filed earlier than the co-pending application in this rejection. Accordingly, applicant submits that upon appeal of the 35 USC §112 first paragraph rejection, this non-statutory obviousness-type double patenting rejection shall be the only rejection remaining and should be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the appropriate fee and/or petition is not filed herewith and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **BRONNE00104**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,



Sanjay S. Bagade
Registration No. 42,280

Customer No. 40518
Levine Bagade LLP
2483 East Bayshore Road, Suite 100
Palo Alto, CA 94303
Direct: (650) 242-4212
Fax: (650) 284-2180